

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. BEHAN, KEITH D. PERRING
and BRIAN J. WILLIS

Appeal No. 95-2136
Application 07/980,156¹

ON BRIEF

Before KIMLIN, GARRIS and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

¹ Application for patent filed November 23, 1992. According to appellants, this application is a division of Application 07/782,796, filed October 25, 1991, now U.S. Patent No. 5,204,023, issued April 20, 1993.

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DECISION ON APPEAL

This is an appeal from the final rejection of claim 6, the only claim remaining in the present application. A copy of illustrative claim 6 is appended to this decision.

The examiner has not applied prior art against the claimed invention.

Appellants' claimed invention is directed to perfumes and flavors comprising the reaction product of amines and organoleptically acceptable aldehydes. According to appellants, the claimed reaction product removes or reduces unpleasant malodors or off-flavours that arise from the presence of certain aldehydic materials in fats and oils. The aldehyde/amine reaction product reacts with the malodorous aldehydes and removes them from the environment. Hence, the claimed composition removes or reduces malodors or off-flavors while adding the fragrance of perfumes and/or flavors to the environment.

Appealed claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as being based upon a non-enabling disclosure.

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Upon careful consideration of the opposing arguments presented on appeal, we concur with appellants that the examiner's rejection is without merit. Accordingly, we will not sustain the examiner's rejection for essentially those reasons expressed by appellants in their Brief.

The examiner provides the following reasoning as the basis for his rejection at page 4 of the Answer:

It is pointed out that the instant claims are directed of [sic, to] perfumes and flavors without qualification, and the instant specification does not enable that which is claimed by adequately disclosing the actual scope by way of specific examples or established principle. As set forth above and as set forth in the first office action, any and all perfumes and flavors are not enabled such as coffee flavors, tea flavors, vanilla flavors, vanillin, and so forth.

As maintained by appellants, it is well settled that the examiner has the initial burden of establishing lack of enablement by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Armbruster, 512 F.2d 676, 677-78, 185 USPQ 152, 153 (CCPA 1975). In the present case, the examiner has summarily concluded, without the requisite factual support, that not all

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flavors, such as coffee, tea and vanilla, are enabled by appellants' specification. However, the examiner does not satisfy his burden by simply noting that there are no examples in the specification which use coffee, tea and vanilla flavors. It is incumbent upon the examiner to establish with scientific evidence and/or persuasive reasoning that specific perfumes and flavors would be inoperable with the claimed aldehyde/amine reaction product, e.g., they would be incompatible therewith. This the examiner has not done. For instance, the examiner has not explained why one of ordinary skill in the art would be unable to use coffee or tea flavors in the soap bars of appellants' Example 1. Appellants contend that "the composition of the present invention is applicable to all perfumes and flavors for addition to triglycerides or triglyceride derivatives" (page 9 of Brief), and the examiner must have a reasonable basis for doubting the truth of appellants' assertions. In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). However, the examiner has provided no reasonable basis for concluding that the claimed aldehyde/amine

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reaction product cannot be formulated with all perfumes and flavors. We remind the examiner that it is not the function of the claims to specifically exclude possible inoperable substances of a composition. In re Dinh-Nguyen, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974). See also In re Kamal, 398 F.2d 867, 872, 158 USPQ 320, 324 (CCPA 1968) and In re Sarett, 327 F.2d 1005, 1019, 140 USPQ 474, 486 (CCPA 1964).

Based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHUNG K. PAK)	
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APPENDIX

6. Perfumes and flavors comprising a reaction product of an organoleptically acceptable aldehyde and an amine which does not distort the sensory characteristics of the perfumes and flavors, wherein the aldehyde is chosen from:

i) Alkanals of types:

a) $\text{CH}_3(\text{CH}_2)_n\text{CHO}$ where n is 0 to 14 and the
chain may be straight,
branched or cyclic

b) $\text{CH}_3(\text{CH}_2)_m\text{CH}(\text{CH}_3)(\text{CH}_2)_n\text{CHO}$ m + n is 0 to 8

ii) Unsaturated aldehydes of types:

a) $\text{CH}_2=\text{CH}(\text{CH}_2)_n\text{CHO}$ where n is 6 to 9

b) $\text{CH}_3(\text{CH}_2)_m\text{CH}=\text{CH}(\text{CH}_2)_n\text{CHO}$ m + n is 2 to 8

c) Citronellal

d) Phenylpropanals:

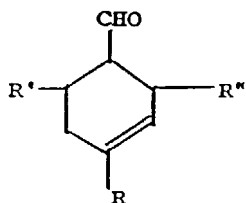
$\text{R}''\text{PhCH}_2\text{CH}(\text{R}')\text{CHO}$ R' is H or CH_3
R'' is H, isopropyl,
tert-butyl

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e) Phenylacetaldehydes:
 PhCH(R)CHO R is H or CH_3

f) Cyclohexene carboxaldehydes:

R, R', R'' are each H or CH_3



g) Cinnamic aldehydes:
 PhCH=CH(R)CHO R = H, CH_3 , pentyl, hexyl

h) Benzaldehydes:
 RPhCHO R is H, isopropyl, OCH_3 or
tertbutyl

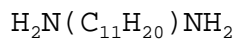
i) Hydroxy derivatives of a) to h);

and the amine is chosen from:

i) Aminoalkanes of general formula:
 R NH_2 Where R is C_1 to C_{16} alkyl,
aryl or aralkyl,

ii) Diaminoalkanes of general formula:

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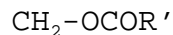


Where $(\text{C}_8\text{H}_{20})$ includes linear
and branched chains and n
is a maximum of 10,

iii) Alkanolamines of general formula:

$(\text{NH}_2)(\text{C}_8\text{H}_{20})(\text{OH})$, where n is a maximum of 10, and their
alkyl and (poly)oxyethylene ether
derivatives,

Phosphatidylethanolamines of the type:



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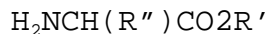


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R', R'' are each fatty acid
alkyl residues containing
at least 12 carbon atoms,

iv) Alpha-amino acid esters of the type:



R' is CH_3 , Ph, PhCH_2 , C_2 to C_4 straight and branched
alkyl groups,

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R" is H, CH_3CH_2 , $\text{CH}_3\text{CH}_2\text{CH}(\text{CH}_3)$,

$(\text{CH}_3)_2\text{CHCH}_2$, H_2NCO , HSCH_2 ,

$\text{RO}_2\text{CCH}_2\text{CH}_2$, $\text{CH}_3\text{SCH}_2\text{CH}_2$, HOCH_2 ,

$(\text{CH}_3)_2\text{CH}$, PhCH_2 ,

p-hydroxyphenylmethyl,

v) Beta-, or gamma-amino acid esters of general formula:

$\text{H}_2\text{N}(\text{CH}_2)_n\text{CO}_2\text{R}$

n is 2 or 3,

R is CH_3 , Ph, PhCH_2 , C_2 to C_4

straight and branched alkyl
groups.